

### REMARKS

This is a full and timely response to the non-final Official Action mailed **June 24, 2004** (Paper No. 1). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, the specification and claims 1 and 4-7 have been amended. No original claims have been cancelled. Claims 13-44 are withdrawn subject to a Restriction Requirement. Additionally, new claims 45-66 have been added. Applicant hereby affirms that the newly added claims are all drawn to the elected invention. Thus, claims 1-12 and 45-66 are currently pending for the Examiner's consideration.

In the recent Office Action, the Examiner indicates that claims 4, 6 and 7 contain allowable subject matter. Applicant wishes to thank the Examiner for this indication of allowable subject matter.

Accordingly, each of claims 4, 6 and 7 have been amended herein and rewritten as an independent claim. Consequently, following entry of this amendment, claims 4, 6 and 7 should be in condition for allowance based on the Examiner's identification of allowable subject matter.

The recent Office Action also contains a statement of reasons for the allowability of claims 4, 6 and 7. Applicant agrees with the Examiner's conclusions regarding patentability, without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicant believes that the application is allowable because the prior art fails to teach, anticipate or render obvious the invention as claimed, independent of how the claims are paraphrased.

All of the newly added claims are dependent, directly or ultimately, on either claim 4, 6 or 7. Therefore, the newly added claims are thought to be clearly allowable over the prior art by virtue of the allowable subject matter identified in claims 4, 6 and 7.

The present Office Action also includes a Restriction Requirement which alleges that the present application claims three different inventions represented by (1) claims 1-12, (2) claims 13-29 and (3) claims 30-44. In a phone conversation of June 8, 2004, Applicant provisionally elected claims 1-12 for present examination. Applicant hereby affirms that election. Consequently, claims 13-44 are labeled as “withdrawn” herein.

The present Office Action next notes a number of informalities in the specification. These informalities have generally been corrected by the present amendment.

One of the alleged informalities is that Applicant has not stated which alcohols are useful in the invention as claimed in claim 9 and 10. Applicant respectfully traverses this position of the Office. Applicant has disclosed that alcohols generally are useful in the invention and, as noted in the Office Action, has given at least one working example.

There is no requirement that Applicant review in the specification all alcohols as to their possible application in the claimed invention. One of skill in the art can determine, without undue experimentation, whether any particular alcohol is particularly useful in the claimed invention. Therefore, this objection to the specification should be reconsidered and withdrawn.

Consequently, following entry of this amendment, the specification is believed to be in proper form. Notice to that effect is respectfully requested.

With regard to the prior art, claims 1-3, 5 and 11 are rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,340,868 to Strauss et al. ("Strauss"). Claim 8 was rejected under 35 U.S.C § 102(b), or alternatively § 103(a), based on Strauss. For at least the following reasons, this rejection is respectfully traversed.

Claim 1 recites:

A binder composition, which comprises:  
an acid including a phosphate ion; and  
a polyacid;  
wherein said acid and said polyacid are mixed with an aqueous solvent, and  
wherein said composition is primarily said aqueous solvent.  
(emphasis added).

In contrast, Strauss does not teach or suggest a composition comprising an acid that includes a phosphate ion, as claimed. The Office Action does not indicate how or where, or even allege, that Strauss teaches the claimed binder composition comprising an acid including a phosphate ion.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claims 1, 2, 3, 5, 8 and 11 based on Strauss should be reconsidered and withdrawn.

Claims 1 and 11 were also rejected under § 102(b) as anticipated by U.S. Patent No. 4,183,759 to Epstein ("Epstein"). For at least the following reasons, Applicant also traverses this rejection.

Again, claim 1 recites:

A binder composition, which comprises:  
an acid including a phosphate ion; and

a polyacid;  
wherein said acid and said polyacid are mixed with an aqueous solvent, and  
wherein said composition is primarily said aqueous solvent.  
(emphasis added).

In contrast, Epstein does not teach or suggest a composition which is primarily an aqueous solvent. Rather, Epstein teaches away from such a composition. According to the Epstein, a composition is prepared with “water in an amount of below 5% the total weight of the mix.” (Col. 2, lines 11-13).

The aqueous component of the claimed binder is important because, as explained in, for example, paragraph 0015 of Applicant’s specification, the binder is to be deposited by inkjet or drop-on-demand technology and must, therefore, have a lower viscosity. The composition taught by Epstein is not identical to, and does not anticipate, the composition claimed by Applicant. The composition taught by Epstein could not be used as the composition claimed by Applicant is to be used.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claims 1 and 11 based on Epstein should be reconsidered and withdrawn.

Claims 9, 10 and 12 were rejected under § 103(a) over the combined teachings of Strauss and U.S. Patent Application Publication 2002/0188055 to Chen et al. Claims 9, 10 and 12 all depend from claim 1. Consequently, this rejection is respectfully traversed on the same grounds given above with regard to the rejection of claim 1 based on Strauss.



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For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: 16 September 2004

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**CERTIFICATE OF MAILING**

DATE OF DEPOSIT: September 16, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail on the date indicated above in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

Rebecca R. Schow

IN THE DRAWINGS:

A replacement sheet for the Figure is filed herewith to re-label the figure as "Figure" consistent with the specification, rather than "FIG. 1."